

II. General Remarks Concerning This Response

Claims 1-9, 10, 11, 14-21, 23, 24, 27-34, 36, and 37 are currently pending in the present application. Claims 1, 8, 10, 14, 21, 23, 27, 34, and 36 have been amended; no claims have been added; and claims 9, 12, 13, 22, 25, 26, 35, 38, and 39 have been canceled. Reconsideration of the claims is requested.

III. Summary of Present Invention

A method, apparatus, system, or computer program product facilitates trustworthy electronic commerce by providing a methodology for uniquely identifying a product offered for sale online so as to improve the trustworthiness of a purchase that was initiated electronically. A product for sale in an online auction has a unique, tamper-resistant, physical tag applied to the product, after which the product or object is photographed as a digital image; the image of the product is subsequently sent to a buyer in some manner, e.g., by being posted by the seller as part of an online auction process that the buyer is viewing. Assuming the buyer agrees to buy the product, the buyer eventually receives the product, presumably with the tamper-resistant tag physically attached to the product. The buyer then has increased confidence both before and during the exchange of the product that the product is identical to the product that was described via the image of the product.

IV. 35 U.S.C. § 101-Non-statutory subject matter

The Office action has rejected independent claim 1 and its dependent claims 7 and 8 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. In response, Applicant has amended independent claim 1 to recite that specific steps are performed by computing systems in cooperation with communication networks. Applicant respectfully requests the withdrawal of the rejection.

V. 35 U.S.C. § 103(a)—Obviousness—Woolston

The Office action has rejected claims 1, 2, and 6-39 under 35 U.S.C. § 103(a) as unpatentable over Woolston, "Facilitating internet commerce through internetworked auctions", U.S. Patent No. 6,202,051 B1, filed 04/26/1995, issued 03/13/2001. Claims 3-5 were rejected under 35 U.S.C. § 103(a) as unpatentable over Woolston in view of Shkedy, "Method and apparatus for facilitating buyer-driven purchase orders on a commercial network system", U.S. Patent Number 6,260,024 B1, filed 12/02/1998, issued 07/10/2001. These rejections are traversed.

The rejection of independent claim 1 admits that the fourth element of claim 1 is not disclosed by Woolston. Independent claim 1, as amended, reads as follows:

1. A method for processing a transaction in electronic commerce, the method comprising:

receiving a transaction message at a computer system through a communication network from a seller, wherein the transaction message comprises a description of goods to be transferred during a transaction between a seller of the goods and a buyer of the goods;

creating a transaction tag to be associated with the goods during the transaction, wherein the transaction tag uniquely identifies the goods in the transaction, and wherein the transaction tag is a physical tag;

sending the transaction tag to the seller;

receiving, at a computer system through a communication network from the seller, a digital image to be associated with the transaction, wherein the digital image comprises an image of the goods on which the transaction tag has been attached, the transaction tag being visible within the digital image; and

sending the digital image from a computer system through a communication network to one or more viewers.

More specifically, the rejection of claim 1 states on page 6 of the Office action that "Woolston, explicitly, does not disclose transaction tag being visible within digital image." To address the fourth element of claim 1, the rejection makes an argument that the use of a driver license or an ID badge is analogous to the claimed element:

It is well known that the driver license and many ID badges (visible by wearing it in office building) are coded with pictures of the drivers (people) and car registration tags are coded with bar code to be visible on car window. Further, in auto-auctions each car is tagged with a number as an identifier visible on windows to be referred by the buyer/seller [sic]. Additionally, real estate advertisements found on-line, newspapers, at street corners or faxed by agents provide detail specification on the property, sketches and/or picture (image) affixed with it to enable the buyer to visualize what he/she is considering or buying.

Applicant finds this argument mostly irrelevant as the present invention is concerned specifically with associating an image with a product for sale wherein the image shows a specifically created tag affixed to the product. Nonetheless, Woolston, though, does disclose the printing and affixing of bar codes on products that are to be sold in online auctions. However, the rejection of the original claim 8 states on page 7 of the Office action: "Woolston, discloses physically shipping [C3 L35-L36] but, explicitly, does not disclose creating a physical transaction tag and mailing the physical transaction tag to the seller."

Thus, as admitted by the rejections of claims 1 and 8, Woolston does not disclose the generation of a physical tag by neither the seller nor the buyer, e.g., by an online service, for a product to be sold in an online auction such that the physical tag can later appear in an image of the product in the online auction. In addition, Woolston does not disclose the generation of the physical tag by the online service, after which it is sent to the seller.

Applicant has amended independent claim 1 to capture this embodiment of the invention in the present application that the Office action admits is not disclosed by Woolston. Thus, with respect to this embodiment, it should also be noted that the Office action has admitted that Woolston does not disclose this claimed embodiment, and the amendment to the claims has not narrowed the claimed invention with respect to this embodiment in view of the prior art. More importantly, the second element of claim 1 has been amended to include the phrase "wherein the transaction tag is a physical tag" such that the step of creating a transaction tag results in the creation of a physical tag. Interpreting the amended language in view of the context of the remainder of the claims, it is clear that the transaction tag is not created by either the seller of the goods or the buyer of the goods. Hence, independent claim 1 now recites an embodiment of the present invention in which a physical transaction tag is created and then sent to the seller, who then digitally photographs the goods on which the physical transaction tag has been affixed, and the digital image is sent to the online service so that it may be viewed by potential buyers. Woolston clearly does not disclose this process, notwithstanding the attempted analogies in the Office action to a driver license or an ID badge.

More importantly, it would not have been obvious to one having ordinary skill in the art to have hypothetically modified the system that is disclosed in Woolston to reach the claimed invention, notwithstanding the motivational statement on page 6 in the Office action, which states:

It would have been obvious at the time the invention has made to a person having ordinary skill in the art to modify the disclosure of Woolston and include an instruction to post the image with item together to allow the user (buyer) to easily associate (identify) the item he/she refers to [sic] and minimize confusion and to aid posting.

The motivational statement in the rejection is completely generic as it merely states that an image allows a potential buyer to identify an item that is being bought; the same could be said about many identification procedures for selling goods. The motivational statement does not provide any nexus between the claimed features of the present invention and any particular suggestion or motivation within the prior art for someone to have used the process that is claimed in the present patent application. More importantly, there was no motivation in the prior art for performing the process of the present invention to obtain the advantages of the present invention; in other words, there was no motivation in the prior art for performing the process of the present invention in which an online service generates a physical tag to be affixed to an object to be sold, which would be subsequently photographed with the affixed tag by the seller such that the potential buyers may view the object with the affixed tag. The present invention provides the ability for the buyers to verify if the object that is delivered is the same object that was viewed online by comparing the tag that is affixed to the delivered object with the tag that appeared during the online auction.

Independent claim 10 was rejected using the argument that was applied against independent claim 1 because claim 10 is similar to claim 1. Applicant has amended claim 10 to specifically state that the transaction tag is a physical tag. Thus, Applicant asserts that the rejection of claim 10 is deficient for the same reasons as the rejection of claim 1.

A combination of Woolston and Shkedy was applied against dependent claims 3-5. Applicant asserts that the references and the rejection are deficient with respect to claims 3-5 for the same reasons that were argued above with respect to independent claim 1 because claims 3-5 include the elements of claim 1.

Independent claims 14, 23, 27, and 36 are similar to independent claim 1; these other independent claims were addressed by the Office action as merely being similar to independent claim 1. Hence, Applicant asserts that the references and the rejection are deficient with respect to independent claims 14, 23, 27, and 36 and their dependent claims for the same reasons that were argued above with respect to independent claim 1.

Examiner bears the burden of establishing a *prima facie* case of obviousness

The examiner bears the burden of establishing a *prima facie* case of obviousness based on the prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985). In response to an assertion of obviousness by the Patent Office, the applicant may attack the Patent Office's *prima facie* determination as improperly made out, present objective evidence tending to support a conclusion of nonobviousness, or both. *In re Fritch*, 972 F.2d 1260, 1265, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992).

With respect to the claims of the present patent application, Applicant respectfully submits that the applied references cannot be combined nor modified to produce the claimed invention. Hence, a rejection of the claims cannot be based upon

the cited prior art to establish a *prima facie* case of obviousness. Therefore, a rejection of the claims under 35 U.S.C. § 103(a) has been shown to be insupportable in view of the cited prior art, and the claims are patentable over the applied references. Applicant respectfully requests the withdrawal of the rejection of the claims.


VI. Conclusion

It is respectfully urged that the present patent application is patentable, and Applicant kindly requests a Notice of Allowance.

For any other outstanding matters or issues, the examiner is urged to call or fax the below-listed telephone numbers to expedite the prosecution and examination of this application.

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Respectfully submitted,



Joseph R. Burwell
Reg. No. 44,468
ATTORNEY FOR APPLICANT

Law Office of Joseph R. Burwell
P.O. Box 28022
Austin, Texas 78755-8022
Voice: 866-728-3688 (866-PATENT8)
Fax: 866-728-3680 (866-PATENT0)
Email: joe@burwell.biz